



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/587,997

08/01/2006

Andreas Eipper

12810-00334-US1

4348

30678

7590

04/12/2011

CONNOLLY BOVE LODGE & HUTZ LLP

1875 EYE STREET, N.W.

SUITE 1100

WASHINGTON, DC 20006

EXAMINER

LEE, DORIS L

ART UNIT

PAPER NUMBER

1764

MAIL DATE

DELIVERY MODE

04/12/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/587,997	Applicant(s) EIPPER ET AL.	
	Examiner DORIS L. LEE	Art Unit 1764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. No new grounds of rejection are set forth below. Thus, the following action is made final.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

DETAILED ACTION

Claim Rejections - 35 USC § 103

3. **Claims 1-14** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Gareiss et al (US 6,084,012)** in view of **Davis et al (GB 2 324 797)**

The rejection is adequately set forth in paragraph 2 of the Office Action mailed on September 28, 2010 and is incorporated here by reference.

Double Patenting

4. **Claims 1-14** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over **claims 1-20** of copending **Application No. 11/996,489**.

The rejection is adequately set forth in paragraph 23 of the Office Action mailed on September 28, 2010 and is incorporated here by reference.

Claims 1-14 are directed to an invention not patentably distinct from **claims 1-20** of commonly assigned **Application No. 11/996,489**.

The rejection is adequately set forth in paragraph 24 of the Office Action mailed on September 28, 2010 and is incorporated here by reference.

5. **Claims 1-14** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over **claims 1-20** of copending **Application No. 11/815,238**.

The rejection is adequately set forth in paragraph 25 of the Office Action mailed on September 28, 2010 and is incorporated here by reference.

Claims 1-14 are directed to an invention not patentably distinct from **claims 1-20** of commonly assigned **Application No. 11/815,238**.

The rejection is adequately set forth in paragraph 26 of the Office Action mailed on September 28, 2010 and is incorporated here by reference.

Response to Arguments

6. **Applicant's argument:** A skilled artisan would not have a reasonable expectation of success that adding a hyperbranched polymer according to Davis to the thermoplastic molding compositions of Gareiss would result in such a dramatic increase of the MVR. Applicants cite MPEP 715.02 (a) II as support for unexpected results.

Examiner's response: *The examiner has considered the data presented in the results. It is not persuasive most notably because the data is not commensurate with the scope of the claimed invention. For example, applicant claims component A) can be present in the range from 10 to 99.99% by weight; however, the applicant provides data mainly in the 90-99 wt % range. Applicant also argues that the MVR value is unexpectedly high for the inventive compositions. However, it is noted that the MVR for the comparative example 2C is 54.5 which higher than the MVR value for inventive*

Art Unit: 1764

example 6 (34.4) which does not support the applicant's argument that the inventive composition has unexpected high MVR values.

7. **Applicant's argument:** The Office Action fails to provide a proper rationale or motivation as to why a skilled artisan would have combined Gareiss and Davis to arrive at the claimed subject matter. Davis does not clearly identify the hyperbranched polycarbonate and only references to thermoplastic compositions. A skilled artisan would assume that plasticizers are additives for PVC materials as evidenced by the enclosed excerpt.

Examiner's response: *The examiner has provided adequate motivation to combine the references and it is clearly stated in the rejection (to control the processability of the thermoplastic polyester by behaving like a reactive plasticizer, (Davis, page 16, last paragraph). Although the cited paragraph does not explicitly state hyperbranched polycarbonate, rather it says "hyperbranched polymers of this invention" which as the Abstract of Davis states can be a hyperbranched polycarbonate. The argument that plasticizers are used in PVC materials is moot because Davis clearly teaches in the final paragraph on page 15 that the plasticizers can be incorporated in thermoplastic compositions. Gareiss teaches that the composition is a thermoplastic polyester.*

8. **Applicant's argument:** Davis does not teach the hyperbranched polycarbonate as presently claimed. The processability of the hyperbranched polymers of Davis is inferior and may cause instability in the molding composition.

Examiner's response: *Applicant's argument that Davis does not teach the hyperbranched polycarbonate as presently claimed is not persuasive because although*

Art Unit: 1764

applicants argue that the prior art polycarbonates have carbonyldiimidazole as end groups whereas the presently claimed polycarbonates do not, is not persuasive because Davis teaches that the imidazole groups can be reacted to form different groups if desired (page 6, first full paragraph). As to the poor processability of Davis's hyperbranched polycarbonates, as no data has been provided by applicant to show this poor performance, no definitive conclusion can be drawn.

Double patenting rejections:

9. The double patenting rejection set forth against copending application **10/587,998** in paragraph 4 of the Office Action mailed on September 28, 2010 is withdrawn in light of the terminal disclaimer filed in the copending application on November 16, 2010.

10. The double patenting rejection set forth against copending application **11/575,646** in paragraphs 5 and 6 of the Office Action mailed on September 28, 2010 is withdrawn in light of the terminal disclaimer filed in the copending application on November 5, 2010 as well as the statement of common ownership filed on July 15, 2010.

11. The double patenting rejection set forth against copending application **11/577,009** in paragraphs 7 and 8 of the Office Action mailed on September 28, 2010 is withdrawn in light of the terminal disclaimer filed in the copending application on September 13, 2010.

Art Unit: 1764

12. The double patenting rejection set forth against copending application **11/577,587** in paragraphs 9 and 10 of the Office Action mailed on September 28, 2010 is withdrawn in light of the abandonment of the copending application.

13. The double patenting rejection set forth against copending application **11/577,590** in paragraphs 11 and 12 of the Office Action mailed on September 28, 2010 is withdrawn in light of the applicant's arguments which are persuasive.

14. The double patenting rejection set forth against copending application **11/632,711** in paragraphs 13 and 14 of the Office Action mailed on September 28, 2010 is withdrawn in light of the terminal disclaimer filed in the copending application on January 6, 2011.

15. The double patenting rejection set forth against copending application **11/659,506** in paragraph 15 and 16 of the Office Action mailed on September 28, 2010 is withdrawn in light of the terminal disclaimer filed in the copending application on September 21, 2010 and a statement of common ownership on July 26, 2010.

16. The double patenting rejection set forth against copending application **11/659,625** in paragraph 17 and 18 of the Office Action mailed on September 28, 2010 is withdrawn in light of the terminal disclaimer filed in the copending application on September 21, 2010 and a statement of common ownership on August 16, 2010.

17. The double patenting rejection set forth against copending application **11/813,638** in paragraphs 19 and 20 of the Office Action mailed on September 28, 2010 is withdrawn in light of the abandonment of the copending application.

Art Unit: 1764

18. The double patenting rejection set forth against copending application **11/632,711** in paragraphs 21 and 22 of the Office Action mailed on September 28, 2010 is withdrawn in light of the terminal disclaimer filed in the copending application on September 21, 2010.

19. The double patenting rejection set forth against copending applications 11/996,489 and 11/815,238 are maintained because the rejection is proper it will be maintained until such time as a proper response to it is filed or conditions appropriate for removal of the rejection are present. As this not the only rejection remaining in the earlier filed of the two pending application, the withdrawal of these double patenting rejections are not appropriate at this time. See MPEP 804 B. 1.

Conclusion

20. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 1764

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DORIS L. LEE whose telephone number is (571)270-3872. The examiner can normally be reached on Monday - Thursday 7:30 am to 5 pm and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571)272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Doris L Lee/
Examiner, Art Unit 1764

/Vasu Jagannathan/
Supervisory Patent Examiner, Art Unit 1764

Application/Control Number: 10/587,997
Art Unit: 1764

Page 9